



Attorney Docket 82295

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Tak Chi SHER

Serial No. 09/830,116

Art Unit: 2834

Filed: April 24, 2001

Examiner: M. O. Budd

For: **IMPROVED HAMMER FOR PIEZOELECTRIC ACTUATOR AND METHOD FOR
PRODUCING SAME**

**PRELIMINARY AMENDMENT
AND
RESPONSE TO RESTRICTION/ELECTION REQUIREMENT**

Commissioner of Patents
Washington, D.C. 20231

Sir:

This is in response to the Office Action having a mailing date of December 11, 2001. The one month shortened statutory period to respond was set to expire January 11, 2002. A petition for a 2-month extension of time and requisite fee are submitted herewith extending the period for response to March 11, 2002.

In view of the following amendments and remarks, the Applicant respectfully requests the Examiner to reconsider and withdraw the outstanding election/restriction requirement and to conduct a substantive examination of all claims pending in the application.

AMENDMENT

Please amend the above identified application as follows:

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IN THE CLAIMS:

Please amend claim 8 as shown on Attachment "A" hereto. A clean copy of the amended claim is herewith provided in Attachment "B".

REMARKS

Claims 1-8 are pending in the application and are presented for a first substantive examination on the merits. Originally filed Claims 1-8 have been subjected to a Restriction Requirement predicated on the assertion that claims 1-6, the Group I claims, and claims 7-8, the Group II claims, are not so linked as to form a single general inventive concept.

By this preliminary Amendment and Response to Restriction requirement, dependent method claim 8 is amended to correct its dependency to depend from independent method claim 7 instead of apparatus claim 6; and a provisional election of the Group I claims, claims 1-6, is made with traverse.

SUMMARY OF RESTRICTION REQUIREMENT

The Examiner has required restriction of claims 1-8 as follows:

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I, claim(s) 1-6, drawn to a hammer for a piezo ignighter.

Group II, claim(s) 7 and 8, drawn to a method of making a hammar for a transducer.

The hammer is classified in class 310 subclass 339. The method is classified in class 29 subclass 25.35.

The inventions listed as Groups I and Group II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: there is no identifiable single special technical feature that link groups I and group II. Manufacturing steps are not related to the finished hammar since the hammar parts could be machined rather than molded.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

ELECTION

Applicant provisionally elects Group I, claims 1-6, with traverse.

TRAVERSAL

Applicant respectfully traverses the Examiner's Restriction Requirement.

Applicant respectfully traverses the Examiner's restriction requirement because Applicant submits that the Examiner has applied the wrong standard for restriction of the instant application.

Applicant respectfully submits that the Examiner has applied the standard for restriction practice applicable to applications filed under 35 U.S.C. § 111 (see e.g., MPEP 806.05(f) - a process of making and a product made by the process can be shown to be distinct inventions if either one or both of the following can be shown: (A) that the process as claimed is not an obvious process of

making the product and the process as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different process.)

The instant application was not filed under 35 U.S.C. § 111 and therefore the above standard is inapplicable.

In contrast, the instant application was filed under 35 U.S.C. § 371 and therefore the appropriate standard is "unity of invention" based on the presence of a special technical feature as required by PCT rules 13.1 and 13.2. See MPEP § 1893.03(d) "unity of invention (not restriction) practice is applicable in international applications (both chapter I and II) and in national stage (filed under 35 U.S.C. § 371) applications.

MPEP § 1850(C) provides that:

The method for determining unity of invention under PCT Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(A) **In addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product,** and an independent claim for a use of the said product; or

(B) In addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process; or

(C) In addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process, it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art of the apparatus or means corresponds

to the contribution the process makes over the prior art.

Thus, **a process shall be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product** with the technical relationship being present between the claimed product and claimed process. **The words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process.** [Emphasis Added.] See also MPEP 1893.03(d).

Applicant respectfully submits that the instant application possess unity of invention as required by PCT Rules 13.1 and 13.2 and is in full compliance with the requirements of MPEP § 1850(C) because the application contains "in addition to an independent claim for a given product (claim 1), an independent claim for a process specially adapted for the manufacture of the said product (claim 7). Moreover, as also provided by MPEP § 1850(C) and 1893.03(d) the process of claims 7-8 shall be considered to be specially adapted for the manufacture of the product of claims 1-6 because the claimed process inherently results in the claimed product. As further noted in MPEP § 1850(C) and 1893.03(d), the words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process.

Thus, although the Examiner has asserted that the claimed piezoelectric hammer of claims 1-6 could be machined instead of molded as provided by claim 7-8, this is irrelevant to the unity of invention analysis as required by PCT rules 13.1 and 13.2. Moreover, because the claimed process of claims 7-8 inherently results in the claimed product of claims 1-6, Applicant

respectfully submits that unity of invention is present.

Accordingly, reconsideration and withdrawal of the election/restriction requirement is respectfully requested.

CONCLUSION

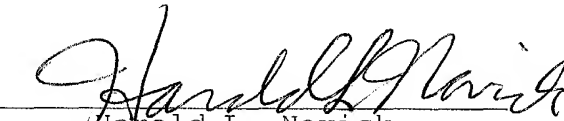
In view of the foregoing, applicant respectfully requests the Examiner to reconsider and withdraw the restriction requirement and to examine all of the claims pending in this application.

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,

NATH & ASSOCIATES

Date: March 6 , 2002


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Attachment "A"
(Marked-Up Copy of Amended Claim)

8. (Amended) The method of claim [6] 7 wherein said hammer ring member is made of plastic material and said hammer body is made of metal materials.

Attachment "B"
Clean Copy of Amended Claim)

8. (Amended) The method of claim 7 wherein said hammer ring
member is made of plastic material and said hammer body is made
of metal materials.
